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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,062	09/29/2005	Hirokatsu Nakano	K036-5637 (PCT)	6359
40627	7590	02/14/2007	EXAMINER	
ADAMS & WILKS 17 BATTERY PLACE SUITE 1231 NEW YORK, NY 10004			NGUYEN, THONG Q	
			ART UNIT	PAPER NUMBER
			2872	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/14/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/551,062	Applicant(s) NAKANO ET AL.	
	Examiner Thong Q. Nguyen	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The present Office action is made in response to the amendment filed on 11/13/06. It is noted that in the amendment, applicant has made changes to the specification, the abstract and the claims. Regarding to the claims, applicant has amended claims 7-8 and added three dependent claims 13-15 into the application. The pending claims 7-15 are examined in this Office action. Note that claims 1-6 were canceled in the pre-amendment of 9/29/05.

Specification

2. The lengthy specification which was amended by the amendment of 11/13/06 has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 7, 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shono (U.S. Patent No. 6,741,284) in view of Cross, Jr. (U.S. Patent No. 4,943,155, of record).

Shono discloses a single lens reflex digital still camera. The camera as described in columns 2-3 and shown in figs. 1-2 comprises an imaging system and an observation system. The imaging system comprises an objective lens system

(10), a quick-return mirror (11) and an imaging pickup device (12). The observation system comprises optics having a focusing plate (12), mirror (14), relay lens (15) and an eyepiece (16). The objective lens system comprises a stationary lens group (10a) and a movable lens group (10b) which moves based on an output signal provided by a control circuit (29) connected to the image pickup device (12). The quick-return mirror (11) is a half mirror which mirror is pivoted about a shaft (22) and disposed between the objective lens system and the image pickup device. The half mirror comprises a first flat surface for reflecting light passing through the objective lens system to the observation system and a rear flat surface for allowing light from the objective lens system to the image pickup device. The only feature missing from the reflex digital still camera provided by Shono is that he does not explicitly disclose that the rear flat surface of the quick-return mirror has an inclined surface with respect to its first flat surface for the purpose of correction an image-formation positional deviation when the quick-return mirror is inserted into the light path from the objective lens system to the image pickup device.

However, the use of an optical element in the form of a wedge configuration (or shape) in place of a parallel shape for the purpose of correcting image aberrations is known to one skilled in the art as can be seen in the system provided by Cross, Jr. In particular, in columns 5-7 and figures 2 and 4, Cross, Jr. has disclosed two embodiments in each embodiment, a wedge-shaped prism is used in place of a parallel plate for the purpose of correcting image aberration.

See the first embodiment described in columns 5-6 and shown in figures 1-2 in which the wedge-shaped prism (127) is used in place of a parallel prism (26) of the convention art for the purpose of correcting image aberration, and in the second embodiment described in columns 6-7 and shown in figures 3-4 in which the wedged-shaped prism (329) is used in place of the parallel prism (229) for the same purpose. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the reflex digital still camera as provided by Shono by using a prism having a first flat surface for reflecting a light beam and a rear flat surface for allowing light passing to an image pickup device wherein the rear flat surface is inclined with respect to the front flat surface as suggested by Cross, Jr. for the purpose of correcting image position when the halfmirror is inserted into the light path between an objective lens system and an image pickup device.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

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F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 7-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,822,802 in view of Cross, Jr. (U.S. Patent No. 4,943,155, of record).

The telescope with the features as recited in present claims 7-15 of the present application is readable from the telescope claimed in Patent claims 1-3 and 6 except the feature related to the inclination of the rear flat surface with respect to the front flat surface of the quick-return mirror in the form of a halfmirror for splitting light to an observation system and for transmitting light to the image element for correcting the image position. Regarding to the new claims 13-14,

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such features are readable from Patent claims 6 and 13-14, in particular, Patent claim 13.

It is noted that the use of an optical element in the form of a wedge configuration (or shape) in place of a parallel shape for the purpose of correcting image aberrations is known to one skilled in the art as can be seen in the system provided by Cross, Jr. In particular, in columns 5-7 and figures 2 and 4, Cross, Jr. has disclosed two embodiments in each embodiment, a wedge-shaped prism is used in place of a parallel plate for the purpose of correcting image aberration. See the first embodiment described in columns 5-6 and shown in figures 1-2 in which the wedge-shaped prism (127) is used in place of a parallel prism (26) of the convention art for the purpose of correcting image aberration, and in the second embodiment described in columns 6-7 and shown in figures 3-4 in which the wedged-shaped prism (329) is used in place of the parallel prism (229) for the same purpose. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the reflex digital still camera as provided by claims 1-20 of Patent 6,822,802 by using a prism having a first flat surface for reflecting a light beam and a rear flat surface for allowing light passing to an image pickup device wherein the rear flat surface is inclined with respect to the front flat surface as suggested by Cross, Jr. for the purpose of correcting image position when the halfmirror is inserted into the light path between an objective lens system and an image pickup device.

Response to Arguments

7. Applicant's arguments with respect to claims 7-12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

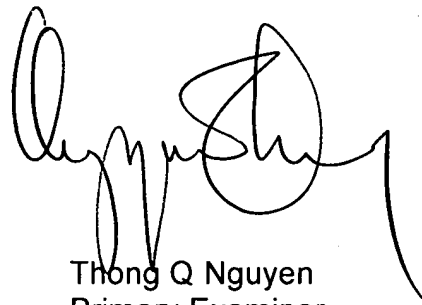
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen B. Allen can be reached on (571) 272-2312. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Thong Q. Nguyen', with a stylized, cursive script.

Thong Q Nguyen
Primary Examiner
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